REMARKS/ARGUMENTS

The Office Action of July 16, 2009, has been carefully reviewed and these remarks are responsive thereto. Claims 25, 34, 42, 45, 46, 48, 55, 62, and 68 have been amended, claims 1, 5, 18-19, 31, 40-41, 47, 52, and 57-59 have been previously canceled, and claims 20, 44 have been currently cancelled without prejudice or disclaimer. Claims 2-4, 6-17, 21-30, 32-39, 42-43, 45-46, 48-51, 53-56, and 60-73 thus remain pending in this Application. Reconsideration and allowance of the instant Application are respectfully requested.

Rejections Under 35 U.S.C. § 101

Claims 20-25 stand rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. More specifically, the Office Action alleges that method claims 20-25 fail to either tie the method steps to a particular machine or show that the steps transform an article. Applicants respectfully disagree. Claim 25 has been amended to tie the method steps to a particular machine. For instance, user data is received "from a data warehouse," conclusions are drawn "with an inferencing engine," and an ontology is found in an ontology store. A data warehouse, an inferencing engine, and an ontology store are described in the specification in paragraphs [65], [68], and Figures 3 and 8, among other places.

In addition, amended independent claim 25 clearly transforms the first nodes into weighted second nodes. According to the Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101 (issued August 24, 2009 by the Office), "transformation of electronic data has been found when the nature of the data has been changed such that it has a different function or is suitable for a different use." (See page 6, lines 1-3 of the Interim Examination Instructions) The weighted second nodes that are generated through the method steps of claim 25 have the function of "indicating a degree to which the user is interested in the concept of the corresponding first node of the ontology." The first nodes of the ontology do not have such a function. Therefore, the first nodes of the ontology are transformed into the weighted second nodes through the method steps of claim 25.

Hence, reconsideration and allowance of claim 25 is respectfully requested. Dependent claims 20-24 depend from independent claim 25 and are directed to statutory subject matter for at least the same reasons as claim 20, and further in view of the various features recited therein.

Rejections Under 35 U.S.C. § 103

Claims 2-4, 6-17, 20-23, 25-31, 32-39, 42-46, 48-51, 53, 55-56, 60-67 and 68-73 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,151,584, hereinafter Papierniak, in view of U.S. Pat. No. 6,317,722, hereinafter Jacobi.

Independent claim 25 has been amended to recite, *inter alia*:

> generating and outputting a list of weighted second nodes, each weighted second node corresponding to one of the first nodes of the ontology, each weighted second node indicating a degree to which the user is interested in the concept of the corresponding first node of the ontology, wherein at least one particular weighted second node is generated dependent on another particular weighted second node being generated, the at least one particular weighted second node and the another particular weighted second node representing related concepts that are not tagged in the user data.

Neither Papierniak nor Jacobi, either alone or in combination, teach or suggest at least this feature of amended independent claim 25. The Office Action on page 4 admits that Papierniak fails to teach this feature of claim 25 but also alleges that Jacobi describes this feature. (See Final Office Action, page 4, "Papierniak fails to teach 'each weighted second node corresponding to one of the first nodes of ontology, each weighted second node corresponding to one of the first nodes of ontology, each weighted second node indicating a degree to which the user is interested in the concept of the corresponding first node of ontology. … However, Jacobi teaches weighting a known item of interest corresponding to similar items on the list and how they are weighted (C. 6 1. 40-50 and C. 11 1. 25-38). Jacobi weights 'similar items list' based on the corresponding rating given by the user.")

However, while Jacobi may describe a recommendation service where similar items are

weighted based on items of known interest, Jacobi does not disclose or suggest a system "wherein at least one particular weighted second node is generated dependent on another particular weighted second node being generated, the at least one particular weighted second node and the another particular weighted second node representing related concepts that are not tagged in the user data." Assuming, but not conceding, that a known item of Jacobi constitutes a first node, and an item of similar interest of Jacobi constitutes a second node, Jacobi merely describes that the each item in the similar items list is stored together with a commonality index ("CI") value which indicates the relatedness of that item to the known item of interest. (See Jacobi, col. 9, line 59 – col. 10, lines 10.) Significantly, Jacobi is limited to only comparisons between a known item of interest and a potential similar item. Indeed, it is not surprising that Jacobi is completely devoid of any description that the similar items included in the table are generated dependent on another similar item in the table. This distinction has been made clear with the added claim feature of "the at least one particular weighted second node and the another particular weighted second node representing related concepts that are not tagged in the user data." As such, Jacobi fails to teach or suggest the claim 25 feature of "at least one particular weighted second node is generated dependent on another particular weighted second node being generated, the at least one particular weighted second node and the another particular weighted second node representing related concepts that are not tagged in the user data."

Independent claim 25 has also been amended to recite, *inter alia*, "receiving user data corresponding to a user wherein said user is de-identified in the user data." Neither Papierniak nor Jacobi, either alone or in combination, teach or suggest at least this feature of amended independent claim 25. This feature of claim 25 was part of previous dependent claim 44. The Office Action on page 7 alleges that this feature of claim 25 is taught by Papierniak and cites column 14, lines 65-67 in doing so. However, it is not clear to the Applicants how deletion of data disclosed in Papierniak is being interpreted to constitute "wherein said user is de-identified" as recited in claim 25. Indeed, deleting data is completely distinct in subject matter to de-identifying a user. More specifically, deleting data refers to getting rid of it (i.e., erasing it) whereas de-identification refers to using it without revealing the identity of the user (i.e., anonymously). The Advisory Action issued on 10/27/2009 states that "de-identifying a user is simply deleting identifying information." Applicants respectfully disagree. De-identification of

data involves a process whereby the data may still be retrieved if needed whereas deleting data results in permanent loss of the data. As such, deleting data in an appropriate time as disclosed at col. 14, lines 65-67 of Papierniak fails to constitute the features of claim 25. Moreover, the rest of Papierniak is completely devoid of any mention, let alone teaching or suggestion, of the feature of user data relating to a de-identified user as recited in claim 25.

None of the references of record (Jacobi, financialengines.com, etc) cure this deficiency within Papierniak. Hence, for at least these reasons, claim 25 is in condition for allowance. Dependent claims 21-23, 26-30, 45, and 68 depend from independent claim 25 and are distinguishable for at least the same reasons as claim 25, and further in view of the various features recited therein. Independent claims 34, 42, 48, 55, and 62 have been amended to recite features similar to those discussed above for claim 25. Hence, independent claims 34, 42, 48, 55, and 62 are in condition for allowance for similar reasons given in support of claim 25. Dependent claims 2-4, 6-17, 32-33, 35-39, 43, 46, 49-50, 53, 56, 60-61, 63-67, 69, and 70-73 depend from one of these independent claims and are distinguishable for at least the same reasons as one of these independent claims, and further in view of the various features recited therein.

Claims 24, 51 and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,151,584, hereinafter Papierniak, in view of U.S. Pat. No. 6,317,722, hereinafter Jacobi, and further in view of Financialengines.com. Financialengines.com does not cure the aforementioned deficiencies of Papierniak and/or Jacobi. Therefore, because dependent claim 24 depends from independent claim 25 discussed above, claim 24 is distinguishable for at least the same reasons as claim 25, and further in view of the various features recited therein. Dependent claim 51 depends from independent claim 48 discussed above and is distinguishable for at least the same reasons as claim 48, and further in view of the various features recited therein. Dependent claim 54 depends from independent claim 55 discussed above and is distinguishable for at least the same reasons as claim 55, and further in view of the various features recited therein.

All issues having been addressed, Applicants respectfully submit that the instant Application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the Examiner believes the Application is not in condition for allowance or there are any questions, the Examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

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